

Remarks

This is responsive to the Office Action mailed March 10, 2009. The amendments do not contain new matter and without prejudice solely serve to more particularly point out and distinctly claim that which is patentable.

Independent claims 1 and 9 are amended to more particularly point out and distinctly feature the entertainment media being stored without being encoded for any authorized usage condition, and then the personal storage module subsequently being encoded with the prescribed authorized usage conditions. Support for this amendment is found at least in the specification that discloses offering personal movie storage modules 10 for sale that are preloaded with the entertainment media before the consumer transaction occurs that defines the prescribed authorized usage conditions for the entertainment media (see, for example, specification pg. 5:13 – pg. 6:2).

Rejection Under 35 U.S.C. 112(1)

Claims 1-5, 8-15, 19, 20, 24-26, 32, and 37-39 stand rejected for alleged written description deficiencies, generally in regard to the language reciting the controller as being programmable and the like. Applicant has amended the claims without prejudice to delete the disputed language to obviate the rejection.

However, Applicant respectfully disagrees with the Office's statement that "There is no specific description of...what functions are performed by the controller."¹ For example, on page 5 the specification discloses two ways of storing the entertainment media to the personal storage module; the first way is that the entertainment media is stored at the time of purchase to reflect the consumer's prescribed usage condition, and the second way is that the

entertainment media is preloaded to the personal storage module before the consumer decision is made, so hence without reflecting the consumer's prescribed usage condition. After that disclosure, the specification then states at page 5:28: "During purchase of the movie, purchase center 12 encodes personal movie storage module 10 with instructions...." Clearly, the skilled artisan reading the specification understands that the encoding disclosed there applies equally as well to both previously disclosed ways of storing the entertainment media. The specification then goes on in several instances to disclose the controller 56 functions to control usage of the stored entertainment media in accordance with the prescribed authorized usage conditions.²

Applicant respectfully requests withdrawal of the rejection in view of the clarifying amendments to the claims.

Rejection Under 35 U.S.C. 103

Claims 1-5, 8, 19, 20, 24, 25, 32, 37, and 39 stand rejected as allegedly being unpatentable over Chung (US 6,628,963) in view of Kawakami (US 7,266,202). Applicant respectfully requests reconsideration and withdrawal of this rejection in view of the clarifying amendments made herein.

Claim 1

Independent claim 1 is amended to more particularly point out and distinctly claim *storing...non-encoded entertainment media that is not encoded with any authorized usage condition... and after the storing step...encoding the portable digital storage module with*

¹ Office Action of 3/10/2009 pg. 3.

² See, for example, specification pg. 6:21-23; pg. 14:22-28; pg. 18:2-4.

access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media.

Applicant and the Office agree that Chung fails to teach or suggest at least this feature. Kawakami discloses only storing both the content and the related data to the portable device.³ Incidentally, Downs (US 6,226,618 of record) like Kawakami discloses only storing both content and related data to the end user device.⁴

None of the art of record discloses or teaches storing the non-encoded entertainment media to the portable digital storage module as featured by the clarifying amendments to claim 1. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom.

Rejection Under Section 103

Claims 9, 10, and 15 stand rejected as allegedly being unpatentable over Chung in view of Katayama (US 6,651,212) and further in view of Kawakami.

Applicant respectfully points out that the Office's claim construction lists language that is not part of the pending claims, and fails to consider some pending language.⁵ For this reason, absent the requested reconsideration and allowance Applicant believes any next rejection cannot rightfully be made final because claim 9 has not been once considered as claimed in the RCE.

³ See, for example, Kawakami col. 8:11-16: "The portable device 6-1 stores the content supplied from the personal computer 1 (i.e., a checked-out content) along with data related with the content (e.g., title or playback limit of each music piece).; see also col. 10:32-40; col. 11:19-56.

⁴ See, for example, Downs col. 21:45-51: "First, upon reception of the Content...marks the Content 113 with a Copy/Play Code 523...before storing it in the End-User Device(s) 109."

⁵ For example, the Office Action interprets "a pocket size enclosure...." which is not pending claim language.

Nonetheless, the Office relies on Kawakami as above in the rejection of claim 1. Applicant has amended claim 9 like the amendments to claim 1 to obviate the rejection. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 9 and the claims depending therefrom in view of the clarifying amendments to claim 9.

Rejection Under Section 103

Claims 11-14 stand rejected as allegedly being unpatentable over Chung, Katayama, and Kawakami and further in view of Gibson. Gibson fails to cure the deficiency of the other references in the rejection of the independent claim from which these claims depend. These claims are thereby allowable at least because they depend from an allowable independent claim, for reasons above, and recite additional features. Applicant respectfully requests reconsideration and withdrawal of the rejection of these claims.

Rejection Under Section 103

Claims 26 and 38 stand rejected as allegedly being unpatentable over Chung and Kawakami, and further in view of Downs. As addressed above, Downs fails to cure the deficiency of the other references in the rejection of the independent claim from which these claims depend. These claims are thereby allowable at least because they depend from an allowable independent claim, for reasons above, and recite additional features. Applicant respectfully requests reconsideration and withdrawal of the rejection of these claims.

Conclusion

This is a complete response to the Office Action mailed March 10, 2009. Applicant respectfully requests the passage of all the pending claims to allowance.

Applicant has also submitted herewith a request for telephone interview. Absent allowance, Applicant respectfully requests the opportunity for a telephone interview in order to facilitate a mutual understanding as to what is claimed and what the cited references disclose to facilitate progress on the merits in this case.

The Office is invited to contact the undersigned should any questions arise concerning this response or any other matter in this case.

Respectfully submitted,

By: /Mitchell K. McCarthy/

Mitchell K. McCarthy, Registration No. 38,794
McCarthy Law Group
512 Northwest 12th Street
Oklahoma City, Oklahoma 73103
Telephone: 877.654.6652 or 405.639.3082
www.mccarthyiplaw.com